



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,346	06/12/2001	Robert R. Griffioen	91436-335	2185
22463	7590	04/25/2005	EXAMINER NAHAR, QAMRUN	
SMART AND BIGGAR 438 UNIVERSITY AVENUE SUITE 1500 BOX 111 TORONTO, ON M5G2K8 CANADA			ART UNIT 2191	PAPER NUMBER
DATE MAILED: 04/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/878,346	GRIFFIOEN ET AL.	
	Examiner	Art Unit	
	Qamrun Nahar	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. This action is in response to the amendment filed on 1/25/05.
2. The objection to the oath/declaration is withdrawn in view of applicant's submission of oath/declaration filed on 1/25/05.
3. The objections to claims 1, 2, 8, 18, 19 and 22-24 are withdrawn in view of applicant's amendment.
4. The rejection under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention to claim 16 is withdrawn in view of applicant's amendment.
5. Claims 1-2, 8, 16, 18-19 and 22-24 have been amended.
6. Claims 1-24 are pending.
7. Claims 1-7, 10, 12-17 and 22-24 stand finally rejected under 35 U.S.C. 102(e) as being anticipated by Chiles (U.S. 6,581,157).
8. Claims 8-9, 11 and 18-21 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Chiles (U.S. 6,581,157) in view of Stupek (U.S. 5,960,189).

Response to Amendment

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

Art Unit: 2191

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-7, 10, 12-17 and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Chiles (U.S. 6,581,157).

Per Claim 1 (Amended):

The Chiles patent discloses:

- **a method for upgrading existing firmware on third party hardware** (“a method for updating a memory image in a non-volatile programmable memory in a device in a computing system is provided.” in column 3, lines 36-38)

- **sending a request to said third party hardware requesting identification information and an existing firmware version indicator; receiving a reply from said third party hardware with said identification information and said existing firmware version indicator** (“During system initialization, the version manager 32 determines the version of the device 50a by retrieving the device version 62 in the non-volatile memory 60 of the device 50a. . . The device version detector 240 may send a bus message having a request for the device version 162 over the interconnection system 40 to the ATM/ADSL adapter 250. The device version detector 240 uses the standard interface provided by the operating system for the ATM/ADSL adapter driver 230 to communicate the request to the ATM/ADSL adapter 250. The ATM/ADSL adapter 250 sends a bus message having data including the device version back to the device version detector

240.” in column 7, lines 40-43; and column 9, lines 48-58; ATM/ADSL adapter 250 is interpreted as the third party hardware)

- utilizing said identification information to obtain a stored firmware version indicator for said third party hardware; comparing said existing firmware version indicator with said stored firmware version indicator, if said existing firmware version indicator differs from said stored firmware version indicator, retrieving upgrade firmware for upgrading said existing firmware from a remote location (“The version manager 32 compares the device version 62 with the updated device version, stored in the device driver 30 memory. If the device version 62 of the device 50a is not the same as the updated device version, the device driver 30 converts the memory image in the non-volatile memory 60 of the device 50a to the updated memory image.” in column 7, lines 43-49).

Per Claim 2 (Amended):

The Chiles patent discloses:

- wherein said utilizing said identification information is also to obtain a stored address which addresses said remote location and wherein said retrieving comprises connecting to said remote location as specified by said address (column 6, lines 30-33 and lines 62-67).

Per Claim 3:

The Chiles patent discloses:

- wherein said address is an Internet Protocol (IP) address (column 6, lines 30-33).

Per Claim 4:

The Chiles patent discloses:

- further comprising upgrading said existing firmware with said upgrade firmware (column 7, lines 43-49).

Per Claim 5:

The Chiles patent discloses:

- wherein said upgrading comprises sending said upgrade firmware to a controller for said third party hardware (column 7, lines 43-49).

Per Claim 6:

The Chiles patent discloses:

- wherein said retrieving also comprises retrieving an upgrade firmware version indicator (column 7, lines 40-43).

Per Claim 7:

The Chiles patent discloses:

- wherein said retrieving also comprises retrieving an upgrade firmware version indicator and wherein said upgrading further comprises sending said upgrade firmware version indicator to said controller (column 7, lines 40-49).

Per Claim 10:

The Chiles patent discloses:

- wherein said identification information comprises a manufacturer identifier and a part identifier (column 6, lines 46-55).

Per Claim 12:

The Chiles patent discloses:

- wherein said upgrading comprises sending upgrade messages to said third party hardware over a serial link to transfer said upgrade firmware version indicator and said upgrade firmware to said third party hardware (column 9, lines 19-31 and column 10, lines 4-31).

Per Claim 13:

The Chiles patent discloses:

- wherein each upgrade message comprises a fragment indicator to indicate whether or not said each upgrade message is the last upgrade message in a sequence of upgrade messages for transferring said upgrade firmware and said upgrade firmware version indicator (column 9, lines 19-31 and column 10, lines 4-31).

Per Claim 14:

The Chiles patent discloses:

- further comprising awaiting a reply message after sending said each upgrade message (column 9, lines 19-31 and column 10, lines 4-31).

Per Claim 15:

The Chiles patent discloses:

- a method for upgrading existing firmware on third party hardware (“a method for updating a memory image in a non-volatile programmable memory in a device in a computing system is provided.” in column 3, lines 36-38)

- sending a request to said third party hardware requesting identification information and an existing firmware version indicator; receiving a reply from said third party hardware with said identification information and said existing firmware version indicator (“The

device version detector 240 verifies the device version by checking the device version 162 stored in the non-volatile memory 160. The device version detector 240 may send a bus message having a request for the device version 162 over the interconnection system 40 to the ATM/ADSL adapter 250. The device version detector 240 uses the standard interface provided by the operating system for the ATM/ADSL adapter driver 230 to communicate the request to the ATM/ADSL adapter 250. The ATM/ADSL adapter 250 sends a bus message having data including the device version back to the device version detector 240.” in column 9, lines 48-58; ATM/ADSL adapter 250 is interpreted as the third party hardware)

- sending said identification information and said existing firmware version indicator addressed to an address; receiving an upgrade firmware version indicator and upgrade firmware; transferring said upgrade firmware version indicator and said upgrade firmware to said third party hardware (column 9, lines 59-67 to column 10, lines 1-29).

Per Claim 16 (Amended):

The Chiles patent discloses:

- further comprising: before said sending said identification information and said existing firmware version indicator, comparing said existing firmware version indicator with a stored firmware version indicator and sending only if said existing firmware version indicator differs from said stored firmware version indicator (column 9, lines 59-67 to column 10, lines 1-29).

Per Claim 17:

The Chiles patent discloses:

- wherein said sending a request comprises sending a request on power-up (column 6, lines 13-21).

Per Claim 22 (Amended):

This is a system version of the claimed method discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Chiles.

Per Claim 23 (Amended):

This is a computer-readable medium version of the claimed method discussed above (claims 15 and 16), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Chiles.

Per Claim 24 (Amended):

This is another version of the claimed method discussed above (claims 15 and 16), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Chiles.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 8-9, 11 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiles (U.S. 6,581,157) in view of Stupek (U.S. 5,960,189).

Per Claim 8 (Amended):

The rejection of claim 2 is incorporated, and further, Chiles does not explicitly teach wherein said utilizing comprises querying a database with said identification information for a record having said stored version indicator and said stored address. Stupek teaches wherein said utilizing comprises querying a database with said identification information for a record having said stored version indicator and said stored address (column 6, lines 59-67 to column 7, lines 1-6).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Chiles to include wherein said utilizing comprises querying a database with said identification information for a record having said stored version indicator and said stored address using the teaching of Stupek. The modification would be obvious because one of ordinary skill in the art would be motivated to store and retrieve information more efficiently.

Per Claim 9:

The rejection of claim 8 is incorporated, and Stupek further teaches further comprising receiving said database, said database having a plurality of records each comprising identification information, a version indicator, and an address (column 6, lines 59-67 to column 7, lines 1-6).

Per Claim 11:

The rejection of claim 8 is incorporated, and Chiles further teaches wherein said stored version indicator is a stored version number and wherein said received version indicator is a received version number (column 6, lines 46-55).

Per Claim 18 (Amended):

This is a system version of the claimed method discussed above (claims 1 and 8), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including “a local area network (LAN) interface for connection to a LAN; a wide area network (WAN) interface for connection to a WAN; a master processor” (Chiles, column 8, lines 42-67 to column 9, lines 1-8) and “a memory for storing a database” (Stupek, column 3, lines 50-52). Thus, accordingly, this claim is also obvious.

Per Claim 19 (Amended):

The rejection of claim 18 is incorporated, and Chiles further teaches a controller for said third party hardware having a controller LAN interface, a serial interface for connection to said third party hardware, and a controller processor (column 8, lines 42-67 to column 9, lines 1-8).

Per Claim 20:

The rejection of claim 19 is incorporated, and Chiles further teaches wherein said controller processor is operable to: send a request message to said third party hardware interface requesting identification information and a firmware version indicator; receive a reply message over said third party hardware interface with said identification information and said firmware version indicator (column 9, lines 48-58); send said identification information and said firmware version indicator from said controller LAN interface addressed to an address for said master processor; receive an upgrade firmware version indicator and upgrade firmware over said controller LAN interface; send upgrade messages to said third party hardware interface in order to send said upgrade firmware version indicator and said upgrade firmware over said third party hardware interface (column 9, lines 59-67 to column 10, lines 1-29).

Per Claim 21:

The rejection of claim 20 is incorporated, and Chiles further teaches wherein said controller processor is operable to send said request on power-up (column 6, lines 13-21).

Response to Arguments

13. Applicant's arguments filed on 1/25/05 have been fully considered but they are not persuasive.

In the remarks, the applicant argues that:

a) Claim 15 recites sending a request to a third party hardware requesting identification information and an existing firmware version indicator and receiving a reply from the third party hardware with the requested identification information and version indicator. In contrast, Chiles only discloses checking or retrieving a device version store in the non-volatile memory of a device (col. 7, 11. 40-43; col. 8, 11. 35-37; 01. 9, 11. 48-58). Chiles does not disclose requesting and receiving from a third party hardware identification information along with a firmware version indicator. It is submitted that in the embodiments disclosed by Chiles there is no need to retrieve identification information other than the device version because it appears that the version manager is device specific. Therefore, Chiles does not disclose all of the elements recited in Claim 15. Thus, Claim 15 and its dependents, Claims 16 and 17, cannot be anticipated by Chiles and are allowable over the references of record.

Examiner's response:

a) Examiner strongly disagrees with applicant's assertion that Chiles fails to disclose the claimed limitations recited in claims 15, 16 and 17. Chiles clearly shows each and every limitation in claims 15, 16 and 17.

As pointed out in the previous Office Action (Mailed on 06/23/2004), Chiles teaches sending a request to said third party hardware requesting identification information and an

existing firmware version indicator; receiving a reply from said third party hardware with said identification information and said existing firmware version indicator (“The device version detector 240 verifies the device version by checking the device version 162 stored in the non-volatile memory 160. The device version detector 240 may send a bus message having a request for the device version 162 over the interconnection system 40 to the ATM/ADSL adapter 250. The device version detector 240 uses the standard interface provided by the operating system for the ATM/ADSL adapter driver 230 to communicate the request to the ATM/ADSL adapter 250. The ATM/ADSL adapter 250 sends a bus message having data including the device version back to the device version detector 240.” in column 9, lines 48-58; ATM/ADSL adapter 250 is interpreted as the third party hardware).

In addition, see the rejection above in paragraph 10 for rejection to claims 15, 16 and 17.

In the remarks, the applicant argues that:

b) Similarly, amended Claims 1 and 22 each include requesting and receiving identification information from a third party hardware. Thus, these claims and their dependents also cannot be anticipated by Chiles and are allowable over the references of record.

Examiner's response:

b) The Examiner has already addressed the applicant's arguments regarding requesting and receiving identification information from a third party hardware in the Examiner's Response (a) above. See the Examiner's Response (a) above and the rejection above in paragraph 10 for rejection to claims 1 and 22.

In the remarks, the applicant argues that:

c) Each of Claims 23 and 24 recites retrieving upgrade firmware from a source over a WAN. In contrast, Chiles does not disclose retrieving upgrade firmware from a source over a WAN. Chiles discloses converting the memory image in a non-volatile memory of a device to the updated memory image. In all of the embodiments disclosed in Chiles, the updated memory image is located locally (see for example, figures 2 and 3, references 134, 182 and 234; column 8, lines 35-41; column 9, lines 34-36; column 10, lines 8-20; and Claims 1 and 12) and is not retrieved over a WAN. Since Chiles does not disclose all of the limitations of Claim 23 or Claim 24, Claims 23 and 24 cannot be anticipated by Chiles and are allowable over the references of record.

Examiner's response:

c) Examiner strongly disagrees with applicant's assertion that Chiles fails to disclose the claimed limitations recited in claims 23 and 24. Chiles clearly shows each and every limitation in claims 23 and 24. Chiles teaches retrieving upgrade firmware from a source over a WAN (column 9, lines 19-31; and "The image converter 242 may *download* or program the copy of the updated memory image 234" in column 10, lines 21-24). In addition, see the rejection above in paragraph 10 for rejection to claims 23 and 24.

In the remarks, the applicant argues that:

Art Unit: 2191

d) The Examiner also rejected Claims 8-9, 11 and 18-21, as being obvious over Chiles in view of US 5,960,189 to Stupek. The Applicant again traverses the rejection. Specifically, the Examiner relies on Chiles for disclosing (1) the feature of requesting and receiving identification information in Claims 8-9 and 11; and (2) the feature of retrieving upgrade firmware from a source over a WAN in Claims 18-21. As discussed above, Chiles does not disclose either of these features. Since Chiles and Stupek, either alone or in combination, do not teach or suggest either of these features, it is submitted that Claims 8-9, 11, and 18-21 are not obvious over Chiles in view of Stupek and are allowable over the references of record.

Examiner's response:

d) The Examiner has already addressed the applicant's arguments regarding requesting and receiving identification information and retrieving upgrade firmware from a source over a WAN in the Examiner's Response (a) and (c) above. See the Examiner's Response (a) and (c) above.

Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, see the rejection above in paragraph 12 for rejection to claims 8-9, 11 and 18-21.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 9:30 AM to 6:00 PM.

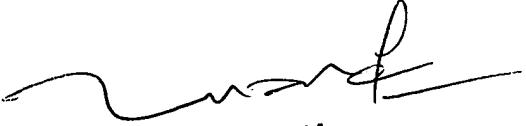
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Art Unit: 2191

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QN
April 18, 2005


TUAN DAM
SUPERVISORY PATENT EXAMINER